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10/507,317

09/10/2004

Nobuo Sugino

3028-001/1336.44264X00

4065

7590

10/26/2005

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EXAMINER

SCHILLING, RICHARD L

ART UNIT

PAPER NUMBER

1752

DATE MAILED: 10/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/507,317

Applicant(s)

SUGINO ET AL.

Examiner

Richard L. Schilling

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1752

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-6 and 8 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 2 and 5 is/are allowed.
- 6) ☒ Claim(s) 1,3,4,6 and 8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 September 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
  - 2) ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 10-09-04;6-22-05
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_

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1. Claims 1, 4 and 8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The term "cellophane to be swelled on a cellophane " in claim 4 is indefinite in meaning. The scope of the term " film such as cellophane or cellophane substitutable material " of the instant claims is indefinite in scope for the films intended to be included. What materials may be substituted for cellophane, i.e. cellulose, is unclear from the specification. What films and their properties that are close enough to cellophane to be included as films such as cellophane is indefinite. What properties and compositions of materials are intended to be close enough to cellophane to be considered to be cellophane substitutable is indefinite from the claims and specification.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 3 and 6 are rejected under 35 U.S.C. 102(b) as being fully met by Fukushima et al. or Sandor. Fukushima et al. ( see particularly col.1, line 59- col.2, line 16; col. 4, lines 23-26; example 3 ) discloses methods comprising transferring resin toner images from release surfaces of sheets to an adhesive sheet using heat. A designing step of an addition toner transfer to the adhesive sheet is also disclosed. Sandor (see particularly col. 2, lines 8-41; col. 3, lines 1-40; col. 4, lines 15-20; col. 6, line 55-col. 7, line 22; example 1 ) discloses transferring toner image designs from

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release sheets to adhesive imprint layers on substrates. A designing step of additional toner design transfers to the imprint layer is also disclosed.

3. The prior art cited by applicants has been considered. The prior art does not disclose processes as in claims 2 and 5 with image transfer to an adhesive sheet from an imaged release sheet followed by retransfer of the resin toner image to another receptor and removal of the adhesive sheet. The closest prior art to claims 1, 4 and 8 is JP 2001-239799 which swells a paste layer not in contact with the toner instead of the copy surface as required by claims 1, 4 and 8.

4. Any inquiry concerning this communication should be directed to Richard L. Schilling at telephone number 571-272-1335.

RICHARD L. SCHILLING  
PRIMARY EXAMINER  
GROUP 1400-1752

